REMARKS

The Applicants request reconsideration of the rejection.

Claims 11-13, 15-17 remain pending.

The Applicants' representative requests a personal interview with the Examiner as soon as the Examiner has received this Reply on her docket. The Applicants believe that an interview will be beneficial to advancing this application to a final disposal, and in particular to allowance, by clearing up some possible misconceptions about the invention and/or the prior art as applied to the rejected claims. Please telephone the Applicants' representative at the number below when the Reply has reached the Examiner's docket.

The Applicants do not understand the Examiner's decision not to consider the claim for foreign priority benefits under 35 U.S.C. §119. The Applicants believe that all requirements for claiming foreign priority benefits to Japanese priority application No. 10-328940 (filed in Japan on November 19, 1998) have been satisfied. A proper claim was made when this continuation application was filed on February 15, 2002, and the certified copy of the Japanese application was filed during prosecution of the parent application, on January 2, 2002. Further, an English-translation of the Japanese priority application was filed on March 23, 2004. Moreover, the Applicants do not understand the reference to the benefit claim regarding an international application filed under 35 U.S.C. §371, inasmuch as the present application was not filed under this section. Finally, the cover page of the Office Action mailed February 7, 2007 indicates that acknowledgment is made of the claim for foreign priority, and that the certified copy has been received. Accordingly, the Applicants request clarification and acceptance of the foreign priority claim in the next Office Action.

Claims 11-17 stand rejected under 35 U.S.C. §35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner appears to find a lack of clarity in the omission from the description of the "more advanced search" referenced on page 11, line 10 of the present application. The Examiner also appears to suggest that page 11, lines 20-28 disclose that the claimed second search is identical to the claimed first search, but using a different database, and that there is no support for automatically searching the second database.

Turning to the first ground, the Applicants respectfully submit that the omission of the "more advanced search" is a permitted expedient, and is desirable to focus the disclosure on the invention itself. Moreover, in this case, it is not clear from the rejection what claimed subject matter is believed not to be enabled.

With regard to the second ground, the Examiner suggests that the second search, as claimed, is nothing more than a new search using the same original input, but to a different database. However, claim 1 requires that the weighted term list be used as the second search input that performs the search of the second document database. In terms of claim 11 (as amended), the invention requires a first search to be conducted of the first document database based on a first search input of a set of key words, fragments of a document or any desired set of documents; retrieving at least one document as a result of the first search, inputting the at least one retrieved document to the first document database; making a weighted term list, whereby each term is given a weight, from the inputted documents, the weight of each term reflecting the importance of the term in the first document database; and performing a search of a second document database based on the weighted term list, wherein

the weighted term list is used as a second search input that performs the search of the second document database.

Furthermore, according to the amended claim 11, the present invention calculates a second weight of each term of each document derived by the second search, and finds the relevance of each document derived from the second document database by calculating an overall weight on both the weighted term list and the calculated second weights with each document with respect to the terms common in both. The Applicants refer the Examiner to the specification at page 6, line 19 – page 7, line 10 for support.

Independent claim 15 is similarly supported, the Applicants noting the steps of

> making a weighted term list, whereby each term is given a weight, from said inputted documents, the weight of each term reflecting the importance of the term in the first document database;
> performing a search of a second document database based on said weighted term list;
> wherein said weighted term list is used as a second search input that performs said search of said second document database.

Any necessary further clarification of these steps can be discussed during the interview requested above.

Claims 11-17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons set forth on pages 4-6 of the Office Action. The claims have been amended to address the Examiner's concerns, but any further clarifications or amendments can be discussed during the interview requested above.

Claims 11-17 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nishioka et al., U.S. Patent No. 6,457,004 (Nishioka). The Applicants traverse as follows.

The second search of the second document database, made using a weighted term list derived from a first search result of a first search of a first document database, in combination with the calculation of a second weight of each term of each document derived from the second document database and the calculation of a relevance of each document derived based on both the weighted term list input for the second search and the second weights for each document, clearly distinguish Nishioka. Nishioka discloses a document retrieval method including a second associative search using documents selected from a search from a first search result, but the second search of Nishioka is conducted to refine or deepen the first search result, such as by searching on the same database, but not to broaden the scope of the search window. In other words, Nishioka does not teach the now-claimed second search of a second document database using a weighted term list derived from the results of the first search.

Further, Nishioka does not disclose or fairly suggest to combine the selected documents derived from the first search with the second search results in calculating the relevance of each document derived from the second search. In particular, Nishioka does not disclose the step of finding out a relevance of each document derived from the second document database by calculating an overall weight on both the weighted term list made from the documents inputted to the first document database (i.e., the results of the first search) and the calculated second weights of the terms of documents derived from the second document database (i.e., by the second search) with respect to terms common to both.

For the foregoing reasons, the Applicants respectfully submit that claims 11-17 are patentably distinguishable from Nishioka.

Claims 11-17 also stand rejected under 35 U.S.C. §102(e) as being anticipated by Barr et al., U.S. Patent No. 5,873,076 (Barr). The Applicants traverse as follows.

Barr discloses an architecture for processing a search query, wherein a first database is searched in response to the search query, and results thereof are presented to a user. A user can then select one of the documents developed by the search, and retrieve the selected document from a second database. Thus, Barr performs a document search according to concepts well known to the art, but does not perform a second document search of a second database, and certainly does not perform a second search according to the present claims. The procedure, according to Barr, that follows the search is no more than the retrieval of the document already developed by the search. In terms of art, Barr's first database contains document indexes, but the second database simply correlates images and/or text to the document indexes. Thus, Barr does not teach or fairly suggest the second search of the claimed invention.

In view of the foregoing amendments and remarks, the Applicants request reconsideration of the rejection and allowance of the claims.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the

deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. NIT-163-02).

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

/Daniel J. Stanger/
Daniel J. Stanger
Registration No. 32,846

DJS/sdb
(703) 684-1120